In Re: RAJH (S.N. 10/823,509)

Response to Oct. 12, 2006 Restriction Requirement

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REMARKS

Applicant submits that the restriction requirement related to species selection is

improper. The PTO has long permitted applicants to define a genus or subgenus by

enumerating species within the genera-the so-called Markush claim format. As such,

the Office cannot require an application under the guise of Section 121, to divide up the

embodiments of a single Markush claim. While Section 121 gives the PTO authority to

restrict between claims of an application, it does not provide authority to reject a single

claim on that basis. In re Weber 580 F.2d 455 at 458.

MPEP Section 803.02 advises Examiners that they should not refuse to examine

a Markush claim that describes what applicants regard as their invention, unless the

subject matter in the claim lacks unity of invention.

In addition to the foregoing, Applicant further traverses on the grounds that the

Markush claims include sufficiently few species that such a search and examination of

each of the two groups of species (one group all biological and the other group all

inorganic metal oxides) at one time would not impose a serious burden on the

Examiner.

An earnest attempt has been made by the Applicant in responding to the October

12, 2006 Restriction requirement. While election has been made, Applicant respectfully

requests that the Examiner reconsider her restriction request. If a telephone interview

would expedite examination of the application, the Examiner is urged to contact the

undersigned.

Separately, and pursuant to the letter to the Official Draftsperson (enclosed),

applicant enters into the record that the Examiner has verified that the pending

application contains nine figures, Figures 1-5 of which have been formalized previously.

Applicant stands ready to formalize (if necessary) remaining Figures 6-9.

Respectfully submitted,

**CHERSKOV & FLAYNIK** 

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